

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Mailed: May 2, 2013

Opposition No. 91208648

DropBox, Inc.

v.

John C Horton

**M. Catherine Faint,  
Interlocutory Attorney:**

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(g)(1) and (2), the Board held a telephonic discovery conference on Tuesday, April 30, 2013, between Candice E. Kim, counsel for DropBox, Inc., and John C. Horton, appearing pro se.<sup>1</sup> Opposer requested the Board's participation via telephone.

The parties confirmed that there are no currently pending related Board proceedings, federal district court actions, or third-party litigation involving both parties. The parties indicated they had not discussed settlement prior to the discovery conference. The parties indicated that they were familiar with the Board's electronic resources.

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<sup>1</sup> Also on the teleconference for opposer were Susan L. Heller, Atty. and Brett Alten.

**1. Legal Representation Strongly Recommended**

As discussed, while Patent and Trademark Rule 11.14 permits any person to represent himself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in inter partes proceedings before the Board to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney. In addition, as the impartial decision maker, the Board may not provide legal advice, though it may provide information as to procedure.

Strict compliance with the Trademark Rules of Practice and, where applicable, the Federal Rules of Civil Procedure, is expected of all parties before the Board. *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1212 (TTAB 2006). If applicant decides to continue without counsel, he is urged to frequently consult the Trademark Trial and Appeal Board Manual of Procedure (TBMP) (3d ed. rev. 2012) and the Trademark rules of practice, which are available from the USPTO website at [www.uspto.gov](http://www.uspto.gov).

**2. Courtesy copies via email**

The parties discussed the email service option now available under Trademark Rule 2.119(b)(6) ("Electronic

transmission when mutually agreed upon by the parties." ).<sup>2</sup> The parties did not agree to this option, but did agree to continue using traditional service options, and to provide courtesy email notification on the date when any paper is served.

### **3. Electronic Resources**

The Board has an electronic filing system that is different than the one used to file Trademark applications and updates to registrations. This system, named ESTTA, may be accessed via the Board's website: <http://estta.uspto.gov/>. To highlight some features of the system, when a filing is made, a pre-populated cover sheet is generated; filings then may be attached in a .PDF format; if the filing has successfully been completed, the filer will receive an ESTTA tracking number; if there are any problems, call the Board at 571-272-8500 and ask to be put through to one of the customer service specialists.

Addresses can be changed easily through an electronic form. Also, consented motions to extend or suspend can be filed and normally an automatic grant of the motion will be generated.<sup>3</sup>

Also available to the parties is the Board's TTABVue system which contains all of the Board's electronic files,

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<sup>2</sup> The additional five days available under Trademark Rule 2.119(c) for traditional service modes (e.g., First Class Mail) is not available for email service.

including the one for this case. The parties may wish to conduct a status check of this case at least twice per month to be sure something is not missed. Most law firms already have a system for periodically checking status, and applicant may access TTABVue through the Board's website at:

<http://ttabvue.uspto.gov/ttabvue/>.

#### **4. TBMP**

The Board directed the parties to TTAB Manual of Procedure, the TBMP, available in an electronic version on the Board's website at

[http://www.uspto.gov/trademarks/process/appeal/tbmp\\_3rd\\_ed\\_rev\\_1.pdf](http://www.uspto.gov/trademarks/process/appeal/tbmp_3rd_ed_rev_1.pdf).

The parties may want to pay particular attention to Chapters 400-800 which describe the conduct of Board proceedings. Chapter 400 describes written discovery tools and discovery depositions. The parties should also look to the Trademark Rules for specific guidance. TBMP § 414 provides an extensive, but not exhaustive, guideline of typical discovery topics in Board proceedings.

#### **5. Initial Disclosures**

Initial disclosures are the witnesses, documents and things having or containing relevant information. Fed. R. Civ. P.

26(a)(1)(A)(i) & (ii):

(i) the name and, if known, the address and telephone number of each individual likely to

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<sup>3</sup> Ordinarily a consented motion to extend or reopen or suspend will be granted by the Board. See TBMP § 509.02, and cases cited therein.

have discoverable information – along with the subjects of that information – that the disclosing party may use to support its claims or defenses, unless the use would be solely for impeachment;

(ii) a copy – or a description by category and location – of all documents, electronically stored information, and tangible things that the disclosing party has in its possession, custody, or control and may use to support its claims or defenses, unless the use would be solely for impeachment.

The Board noted that the exchange of discovery requests could not occur until the parties made their initial disclosures as required by Fed. R. Civ. P. 26(f). The Board also noted that a motion for summary judgment may not be filed until initial disclosures were made by the parties. See Trademark Rules 2.120(a)(3) and 2.127(e)(1). Initial disclosures do not need to be filed with the Board, only served on the other party.

#### ***6. Board's Standard Protective Order***

The Board advised the parties of the automatic imposition of the Board's standard protective order in this case and further indicated that the parties would control which tier of confidentiality applies. Additionally, the Board stated that if the parties wished to modify the Board's standard protective order, they could do so by filing a motion for Board approval. The Board noted that inasmuch as applicant is representing himself *pro se* in this case, he would be unable to view any documents produced by opposer that have been designated "Highly Confidential - For Attorneys Eyes Only." The Board advised,

however, that applicant could contest the appropriateness of the "Highly Confidential - For Attorneys Eyes Only" designation by seeking an *in camera* inspection by the Board of such documents designated "FOR ATTORNEYS EYES ONLY" by opposer.

**7. Review of the Pleadings**

Upon review of the notice of opposition, the Board noted there are claims based on Trademark Act § 2(a) for false suggestion of a connection, based on Trademark Act § 43(c) for dilution, and on Trademark Act § 2(d) for priority and likelihood of confusion. Opposer has the burden of proof in this proceeding.

**a. Notice of Opposition**

**i. Section 2(a) False Suggestion of a Connection**

As noted during the discovery conference, opposer's § 2(a) false suggestion of a connection claim does not allege that opposer's mark is its identity or "persona."

For a proper § 2(a) claim of false suggestion of a connection, a plaintiff must allege facts from which it may be inferred that its mark is famous and points uniquely and unmistakably to itself, as an entity -- i.e., that its mark is its identity or "persona" -- and that purchasers would assume that goods bearing the mark are connected with plaintiff. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

To prevail on a claim of false suggestion of a connection, plaintiff must plead (and prove) the following:

- (1) Defendant's mark is the same or a close approximation of plaintiff's previously used name or identity;
- (2) That the defendant's mark would be recognized as such;
- (3) That the plaintiff is not connected with the activities performed by the defendant under the mark; and,
- (4) That plaintiff's name or identity is of sufficient fame or reputation that when the defendant's mark is used in connection with its services, a connection with the plaintiff would be presumed.

*Consolidated Natural Gas Co v. CNG Fuel Systems, Ltd.*, 228 USPQ 752, 754 (TTAB 1985), citing *Buffett v. Chi Chi's*, 226 USPQ 428, 429 (TTAB 1985).

In view thereof, opposer's Section 2(a) false suggestion of connection claim in paragraph 16 of the notice of opposition is hereby stricken, and defendant's answer to paragraph 16 is also stricken.

**ii. Section 43(c) Dilution**

A proper pleading of a dilution claim requires an allegation as to when the claimant's mark became famous, which does not appear in the notice of opposition. See *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1542 (TTAB 2001); see also *Demon Int'l v. Lynch*, 86 USPQ2d 1058, 1059-60 (TTAB 2008) (dismissing dilution claim as improperly pled because it did not include allegation that opposer's mark is famous).

In view thereof, to the extent opposer believes it has alleged a dilution claim in the notice of opposition as to its intent to use mark, paragraph 17 is hereby stricken and applicant's answer to paragraph 17 is also stricken.

As noted below, opposer is allowed to file an amended notice of opposition within **TWENTY DAYS** of the date of this teleconference. If opposer knows a time certain by which its marks became famous, it should so state. At a minimum, to support the dilution claim, opposer's marks must have become famous before the filing date of applicant's application.

**iii. Section 2(d) Priority and Likelihood of Confusion**

A likelihood of confusion determination under § 2(d) is based on an analysis of the priority of use claim and of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *duPont* factors). There are 13 *duPont* factors, however, not all of the *duPont* factors are relevant or of similar weight in every case. In *re Dixie Restaurants, Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). Opposer's pleading of the claim appears adequate.

**b. Answer**

Applicant's answer contains a significant amount of argument and the Board clarified the answer during the teleconference. The Board construes applicant's answers to paragraphs 1-3, 6-13, 15 and 18 as denials. Applicant clearly admits paragraphs



4 and 5. In paragraph 14 applicant admits the marks are similar, but is without information or knowledge sufficient to form a belief as to the truth of the other allegations in the paragraph. Paragraphs 16 and 17 are stricken. As to applicant's "affirmative defenses," the Board noted that they were more in the way of amplification of applicant's denials and the Board did not strike them at this time.

The Board pointed out to applicant that if there is a need for an amended answer, applicant should clearly respond to any amended notice of opposition in a manner that complies with Fed. R. Civ. P. 8(b) which provides:

In responding to a pleading, a party must:

(A) state in short and plain terms its defenses to each claim asserted against it; and

(B) admit or deny the allegations asserted against it by an opposing party.

(2) Denials — Responding to the Substance.

A denial must fairly respond to the substance of the allegation.

(3) General and Specific Denials.

A party that intends in good faith to deny all the allegations of a pleading — including the jurisdictional grounds — may do so by a general denial. A party that does not intend to deny all the allegations must either specifically deny designated allegations or generally deny all except those specifically admitted.

(4) Denying Part of an Allegation.

A party that intends in good faith to deny only part of an allegation must admit the part that is true and deny the rest.

(5) Lacking Knowledge or Information.

A party that lacks knowledge or information sufficient to form a belief about the truth of an allegation must so state, and the statement has the effect of a denial.

(6) Effect of Failing to Deny.

An allegation – other than one relating to the amount of damages – is admitted if a responsive pleading is required and the allegation is not denied. If a responsive pleading is not required, an allegation is considered denied or avoided.

Applicant was also made aware that it may not "incorporate by reference" other documents into the answer, nor may applicant insert hyperlinks to websites in its answer.

#### **8. *Limits on Discovery***

The Board suggested to the parties that they could adopt various measures to limit the scope of discovery, including agreeing to limit the number of depositions, interrogatories, document production requests, and admission requests. Opposer proposed the following limitations on discovery:

- 25 interrogatories
- 35 document production requests
- 2 factual depositions (in addition to a Fed. R. Civ. P. 30(b)(6) deposition).

Opposer clarified that requests for admissions would be in accordance with Fed. R. Civ. P. 36(a). Applicant requested time to consider the proposed limitations. The Board allowed the parties time in which to further discuss the proposed limitations and to telephone the Interlocutory Attorney, or

submit a written stipulation, regarding any limitations on discovery within **THRITY-FIVE DAYS** of this teleconference.

No limitations on discovery were entered at this time. The parties agreed that they would further discuss settlement in the next week after applicant returned from vacation. Applicant clarified that his telephone number is (910) 515-4140.

#### **9. Availability of ACR**

The Board encourages settlement of matters between the parties. While the Board does not conduct settlement conferences, there is an Accelerated Case Resolution ("ACR") procedure available. The Board explained that the ACR procedure is an expedited procedure for obtaining a final decision from the Board. In order to pursue ACR, the parties must stipulate that the Board can make findings of fact. The parties may review more detailed information about ACR at the Board's website.<sup>4</sup> Should the parties agree to use the ACR procedure, the parties are reminded that they may stipulate to facts after the close of the initial disclosure period and to a shortening of the discovery period. See Trademark Rule 2.120(a)(2).

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<sup>4</sup> Information about the Board's ACR procedure may be viewed at: <http://www.uspto.gov/trademarks/process/appeal/index.jsp>.

**10. Summary**

Paragraphs 16 and 17 are stricken from the notice of opposition. Applicant's answer is clarified as laid out in this order.

Opposer is allowed until May 20, 2013 to file and serve an amended notice of opposition. If an amended notice of opposition is filed, applicant is allowed until **THIRTY DAYS** from the filing of any such amended notice of opposition to file an amended answer.

Within **THRITY-FIVE DAYS** of this teleconference the parties may telephone the Interlocutory Attorney, or submit a written stipulation, regarding any limitations on discovery.

**11. Schedule**

Dates remain as previously set, as copied below.

Discovery Opens:	5/2/2013
Initial Disclosures Due:	6/1/2013
Expert Disclosures Due:	9/29/2013
Discovery Closes:	10/29/2013
Plaintiff's Pretrial Disclosures Due:	12/13/2013
Plaintiff's 30-day Trial Period Ends:	1/27/2014
Defendant's Pretrial Disclosures Due:	2/11/2014
Defendant's 30-day Trial Period Ends:	3/28/2014
Plaintiff's Rebuttal Disclosures Due:	4/12/2014
Plaintiff's 15-day Rebuttal Period Ends:	5/12/2014

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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